

REMARKS

Applicants have carefully reviewed the Office Action mailed August 31, 2009 and offer the following remarks to accompany the above amendments.

Status of the Claims

Claims 39-47, 49-53, and 55-59 were previously pending. Claims 1-38, 48, and 54 were previously cancelled. No claims are added or cancelled herein. Accordingly, claims 39-47, 49-53, and 55-59 remain pending.

Specification

The Specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Patent Office opined that the Specification does not provide proper antecedent basis for “a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously transmitted to the user device.” More specifically, the Patent Office opined that the specification teaches the “time the particular content was *played*” rather than the time the particular content was transmitted. While making no admission as to the propriety of the opinion of the Patent Office, Applicants have amended claims 39, 49, and 55 to replace the phrase “a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously *transmitted to* the user device” with “a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously *played by* the user device.” As such, Applicants respectfully request that the objection to the Specification be withdrawn.

Rejection Under 35 U.S.C. § 101

Claims 55-57 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Patent Office opined that the claims are directed to a “computer-usable medium,” which does not fall within the four statutory categories of classes. While making no admission as to the propriety of the opinion of the Patent Office, Applicants have amended claims 55-57 to be in standard Beauregard format. Specifically, claims 55-57 have been amended to be directed to a computer-readable medium encoded with software for instructing a processor to perform a number of functions. For further clarification, Applicants

have amended claim 55 to state that the computer-readable medium is an article of manufacture. The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility clearly state that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory” (citing *In re Lowry*, 32 F.3d 1579, at 1583-84). As such, Applicants respectfully request that the rejection of claims 55-57 under 35 U.S.C. § 101 be withdrawn.

Rejection Under 35 U.S.C. § 103(a) – Hitson and Logan

Claims 39-46, 49-53, and 55-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0010759 A1 to Hitson et al. (hereinafter “Hitson”) in view of U.S. Patent No. 5,721,827 to Logan et al. (hereinafter “Logan”). Applicants respectfully traverse. Under § 103, “obviousness requires a suggestion of *all limitations in a claim.*” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) (emphasis added)). Thus, in order to reject a claim under § 103, for each limitation of the claim, the Patent Office must show that the limitation is taught or suggested by the cited prior art references or would have otherwise been suggested to one of ordinary skill in the art at the time of the invention. It is further well established that, as stated at MPEP 2106 II.C, “USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)”.

Regarding claim 39, the combination of Hitson and Logan fails to teach or suggest the claimed features of: (1) maintaining a user listening history comprising a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device and *a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously played by the user device* and (2) without selection from the user device, automatically selecting a plurality of broadcast elements comprising a song broadcast element and an advertising broadcast element based on the user profile *and the user listening history*. Specifically, because claim 39 must be read as a whole, the Patent Office must show a user

listening history that comprises at least a portion of a plurality of broadcast elements previously transmitted to a user device and a time at which each of those broadcast elements was previously played by the user device. The Patent Office must then show that that same user listening history (i.e., the user listening history comprising the list of broadcast elements and the times at which the broadcast elements were played at the user device) is used to automatically select a plurality of broadcast elements to be transmitted to the user device.

In the rejection of claim 39, the Patent Office admitted that Hitson fails to teach “a time at which each broadcast element of at least a portion of the plurality of broadcast elements was previously transmitted to the user device.”¹ Therefore, since claim 39 must be read as a whole, the Patent Office has admitted that Hitson fails to teach the claimed features of (1) maintaining a user listening history comprising a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device and *a time at which each broadcast element of the at least a portion of the plurality of broadcast elements was previously played by the user device* and (2) without selection from the user device, automatically selecting a plurality of broadcast elements comprising a song broadcast element and an advertising broadcast element based on the user profile *and the user listening history*.

In order to show the features of claim 39 that are not taught by Hitson, the Patent Office relied on Logan. Specifically, the Patent Office stated:

Logan teaches a player being programmed to play identified segments at particular times of day, such as listening to a scheduled radio broadcast (at least col. 37:14-35). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Logan’s system with Hitson as Hitson does teach the user selecting when to download content in the future by monitoring the time, thereby enabling Hitson’s system at a specified time, as well as scheduling content downloads (at least paragraph 81, 149), and it would have been obvious to combine Logan’s time based broadcast scheduling as Logan identifies it to be useful to listen to particular broadcasts as certain times of day.²

Even if the statements made by the Patent Office above are assumed to be true for purposes of argument, the Patent Office has only shown that the combination of Hitson and Logan teaches that the playlist in Hitson may include content scheduled for a particular time. However, the Patent Office has failed to show that the times for which the content is scheduled in the playlist

¹ Office Action mailed August 31, 2009, p. 5.

² *Ibid.*

of the combined system of Hitson and Logan are stored in a user listening history for the user of the player device. Further, the Patent Office has failed to show that the times for which content is scheduled in the playlist of the combined system of Hitson and Logan are used to automatically select a plurality of broadcast elements to be transmitted to the player device. As such, claim 39 is allowable.

Claims 40-43 depend from claim 39. As such, since claim 39 is allowable, claims 40-43 are also allowable. However, Applicants reserve the right to further address the rejections of claims 40-43 in the future, if needed.

Regarding claim 44, the combination of Hitson and Logan fails to teach or suggest the claimed feature of wherein the plurality of broadcast elements further comprise a personalized broadcast element that includes a reference to a name of the user associated with the user device. In response to Applicants' previous arguments, the Patent Office repeatedly states that the claim terminology is broader than suggested.³ Applicants respectfully traverse. By its very language, claim 44 requires that the plurality of broadcast elements transmitted to the user device include a personalized broadcast element and that this personalized broadcast element includes a reference to a name of the user associated with the user device. In the rejection of claim 39, the Patent Office read the items in the playlist of Hitson as the plurality of broadcast elements. As such, in order to properly reject claim 44, the Patent Office must show that one of the items in the playlist of Hitson includes a reference to a name of the user associated with the player device. The Patent Office has failed to do so. Rather, the Patent Office pointed to the "My Station" feature of Hitson and stated that the claim language reads upon a reference to the "My Station" web page of Hitson.⁴ However, even if a reference associated with the "My Station" web page of Hitson can be read as a reference to the user's name, which Applicants do not concede, the Patent Office has failed to show that such a reference is included in an item in the playlist of Hitson. Since such a reference is not included in an item in the playlist of Hitson, the Patent Office has failed to show the claimed feature of a personalized broadcast element that includes a reference to a name of the user associated with the user device.

Further regarding claim 44, the Patent Office stated that "[t]he claim terminology merely suggests the element somehow referencing a name of the user associated with the user device.

³ *Id.* at p. 10.

⁴ *Ibid.*

Such name referencing, as to the broadest reasonable interpretation, would be, for example, the username in the metadata of the element.”⁵ Assuming only for the purposes of argument that this statement made by the Patent Office is true, the Patent Office is reading the items in the playlist of Hitson as the claimed plurality of broadcast elements transmitted to the user device (see rejection of claim 39). The personalized broadcast element of claim 44 is one of the plurality of broadcast elements transmitted to the user device. As such, even if a username in metadata can be read as the claimed reference to the name of the user associated with the user device included in the personalized broadcast element, the Patent Office has failed to show where the combination of Hitson and Logan teaches that metadata for an item in the playlist of Hitson includes a username of the user of the device to which the playlist is transmitted. As such, the Patent Office has failed to show the claimed feature of a personalized broadcast element that includes a reference to a name of the user associated with the user device. In light of the discussion above, claim 44 is allowable.

Claims 45 and 46 depend from claim 39. As such, since claim 39 is allowable, claims 45 and 46 are also allowable. However, Applicants reserve the right to further address the rejections of claims 45 and 46 in the future, if needed.

Claim 49 is an apparatus claim that includes features similar to those of claim 39. As such, claim 49 is allowable for at least the same reasons set forth above with respect to claim 39. However, Applicants reserve the right to further address the rejection of claim 49 in the future, if needed.

Claims 50-52 depend from claim 49. As such, since claim 49 is allowable, claims 50-52 are also allowable. However, Applicants reserve the right to further address the rejections of claims 50-52 in the future, if needed.

Claim 53 depends from claim 49 and also includes features similar to those of claim 44. As such, since claim 49 is allowable, claim 53 is also allowable. In addition, since claim 53 includes features similar to those of claim 44, claim 53 is also allowable for at least the same reasons set forth above with respect to claim 44. However, Applicants reserve the right to further address the rejections of claim 53 in the future, if needed.

Claim 55 is a computer-readable medium claim having features similar to those of claim 39. As such, claim 55 is allowable for at least the same reasons set forth above with respect to

⁵ *Ibid.*

claim 39. However, Applicants reserve the right to further address the rejection of claim 55 in the future, if needed.

Claims 56 and 57 depend from claim 55. As such, since claim 55 is allowable, claims 56 and 57 are also allowable. However, Applicants reserve the right to further address the rejections of claims 56 and 57 in the future, if needed.

Claim 58 depends directly from claim 43 and indirectly from claim 39. As such, since claim 39 is allowable, claim 58 is also allowable. However, Applicants reserve the right to further address the rejection of claim 58 in the future, if needed.

Claim 59 depends directly from claim 52 and indirectly from claim 49. As such, since claim 49 is allowable, claim 59 is also allowable. However, Applicants reserve the right to further address the rejection of claim 59 in the future, if needed.

Rejection Under 35 U.S.C. § 103(a) – Hitson, Logan, and Mackintosh

Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitson and Logan and further in view of U.S. Patent No. 6,317,784 B1 to Mackintosh et al. (hereinafter “Mackintosh”). Applicants respectfully traverse. The standards for obviousness are set forth above.

Claim 47 depends from claim 39. As such, since claim 39 is allowable, claim 47 is also allowable. However, Applicants reserve the right to further address the rejection of claim 47 in the future, if needed.

Conclusion

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicants' representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: /R. Chad Bevins/

R. Chad Bevins
Registration No. 51,468
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

Date: November 30, 2009
Attorney Docket: 1116-119